REMARKS

Claims 1, 4-9, 11-17, 19-23, 25-38 and 44-47 are pending in the application.

Claims 1, 4-9, 11-17, 19-23, 25-38 and 44-47 have been rejected.

Claims 1, 16, 37, 38, 44 and 45 have been amended, as set forth herein.

Claim 10 has been canceled, without prejudice.

I. PRIOR OFFICE ACTION DATED APRIL 15, 2009 and APPLICANT'S AMENDMENT AND RESPONSE DATED JUNE 15, 2009

The Office issued a final office action with a mailing date of April 14, 2009. In response, at the two month date on June 15, 2009, Applicant submitted claim amendments and arguments placing the claims in condition for allowance and overcoming the rejections made in the April 14 office action.

On July 9, 2009, the outstanding Office Action was mailed and purports to withdraw the April 14 office action, and further, appears to include virtually the same rejections made in the April 14 office action, and the rejections in the outstanding Office Action do not address any of the amendments made to independent Claims 1, 37, 38, 44 and 45 submitted in Applicant's response on June 15, 2009. Based on the foregoing, Applicant believes the claim amendments and arguments made in Applicant's response on June 15, 2009 have not been entered by the Office. Therefore, this new response and claim amendments being made herein are submitted with the understanding that the claim amendments in Applicant's June 15, 2009 response were not entered.

II. REJECTIONS UNDER 35 U.S.C. § 103

Claims 1, 4, 6-9, 11-15, 17-38 and 44 [and Claim 45] were rejected under 35 U.S.C. § 103(a) as being unpatentable over Carter (US Patent No. 6,266,782) in view of Nizamuddin (US Patent No. 5,136,585). Claims 5, 46 and 47 [and Claims 10 and 16] were rejected under 35 U.S.C. § 103(a) as being unpatentable over Carter (US Patent No. 6,266,782) in view of Nizamuddin (US

Patent No. 5,136,585) and further in view of Marchetti (US Patent No. 6,618,398). The rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142. In making a rejection, the examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), *viz.*, (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. In addition to these factual

determinations, the examiner must also provide "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (*In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir 2006) (cited with approval in *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007)).

Initially, with respect to all of the rejections based on the main reference Carter, Applicant respectfully disagrees with the Office Action's assertion that Carter discloses the invention substantially as claimed. In fact, Carter discloses substantially less than that claimed, and Applicant respectfully incorporates by reference its prior response and arguments with respect to Carter and the 103 rejections.

However, to further prosecution, Applicant is amending independent Claims 1, 44 and 45 to include certain elements recited in independent Claim 46, and Applicant is amending independent Claims 37 and 38 to include certain elements recited in independent Claim 47.[1]

Independent Claims 46 and 47 were rejected under103(a) based on Carter, Nizamuddin and Marchetti. As set forth in Applicant's prior responses, the Marchetti reference is unavailable as prior art under 103©)(1) which provides that:

> Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Title 35, United States Code, § 103©)(1). See also, MPEP § 2146.

The present application is owned by Nortel Networks Limited, as evidenced by documents recorded at Reel 011348, Frame 0695 (assignment from the inventors to Nortel Networks Limited). The cited reference, US 6,618,398, shows Nortel Networks Limited as the assignee. Therefore, the present application and the cited reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person. As a result, the Marchetti reference is

[1] Claim 10 is being canceled, without prejudice.

unavailable as prior art under section 103(a) and, at a minimum, independent Claims 46 and 47 are allowable over the art of record.

Since Applicant has amended independent Claims 1, 37, 38, 44 and 45 to include certain claim elements which the Office Action argues are disclosed, taught or suggested by Marchetti, and because Marchetti is unavailable as prior art for the 103 rejections, each of the independent Claims 1, 37, 38, 44, 45, 46 and 47 are allowable -- Marchetti is unavailable as prior art.

Therefore, Applicant respectfully requests withdrawal of this § 103(a) rejections of Claims 1, 4-9, 11-17, 19-23, 25-38 and 44-47.

III. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at ***rmccutcheon@munckcarter.com***.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Nortel Networks Deposit Account No. 14-1315.

Respectfully submitted,

MUNCK CARTER, LLP

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Robert D. McCutcheon
Registration No. 38,717

P.O. Drawer 800889
Dallas, Texas 75380
(972) 628-3632 (direct dial)
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: *rmccutcheon@munckcarter.com*